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Date and Time: October 11, 2002 1:15 PM
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Message: Per our phone conversation, please find attached a copy of the response which was filed on April 25, 2002 in Patent Application No. 09/749,709. A copy of the facsmilie transmission report is also attached.

Regards,

Jonathan M. Hines
Jonathan Hines

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To: Examiner Peter Parus, Art Unit 1632 Entity: U.S. Patent and Trademark Office Fax Number: 703-872-9306 Voice Number: 703-308-8340 From: Patrick Scanlon Date and Time: April 25, 2002 3:37 PM Total Pages: 4		
Message: PLEASE SEE ATTACHED RESPONSE TO OFFICE ACTION IN PATENT APPLICATION NO. 09/749,709		
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- 1 -

Serial No. 09/749,709

19412-1773001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Chengyu Liu et al. : Group Art Unit: 1632
Serial No. 09/749,709 : Examiner: P. Paras
Filed: December 27, 2000 : Response to Paper No. 5

For CONTROLLING OFFSPRING'S
SEX RATIO BY TARGETING
TRANSGENES ONTO THE
SEX CHROMOSOMES

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Assistant Commissioner for Patents,
Washington, DC 20231

SIR:

This is in response to the Office Action dated March 26, 2002.

Claims 1-12 remain pending in the present application.

Restriction has been required between (I) claims 1-12, drawn to a method of producing transgenic animals, wherein the animals are mammals, (II) claims 1-12, drawn to a method of producing transgenic animals, wherein the animals are non-mammalian, and (III) claims 1 and 2, drawn to a method of producing transgenic animals, wherein the animals are unisexual flower plants. This restriction requirement is respectfully traversed.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8 (a))

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Patrick R. Scanlon
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Patrick R. Scanlon

Date: 4/25/02

Serial No. 09/749,709

19412-1773001

The Examiner states that restriction is proper between Groups I, II and III because their inventions "appear" to constitute patentably distinct inventions. The Examiner further states that a separate search is required for each of groups I, II and III.

As an initial point, applicant respectfully disagrees that a separate search is necessarily required for each group. By the Examiner's own statement, Groups I and II are both classifiable in class 800, subclass 25. Thus, there is no indication that a separate search would be required for at least these two Groups.

Moreover, applicant disagrees that the Groups identified by the Examiner are distinct inventions. In MPEP § 802.01, the term "distinct" is defined as meaning that two or more subjects as disclosed are related, but are capable of separate manufacture, use or sale as claimed. Here, the allegedly distinct inventions, as claimed, are not capable of separate manufacture, use or sale because they are defined by the same claims. That is, Groups I and II are both defined by the same claims 1-12 and Group III is defined by claims 1 and 2, which comprise a subset of claims 1-12. Thus, the Groups are not distinct as claimed. As stated in MPEP § 806, restriction is never proper where inventions are related as disclosed but not distinct as claimed.

In addition, MPEP § 803 states that restriction between two or more inventions is proper only if they are able to support separate patents. In this case, it is respectfully submitted that Groups I, II and III could not support separate patents because they are defined by the same claims and 35 U.S.C. 101 precludes more than one patent being issued for the same claims.

For the above reasons, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Serial No. 09/749,709

19412-1773001

Applicant provisionally elects Group I, claims 1-12 for further prosecution.

An action on the merits is awaited.

Respectfully submitted,

4/25/02

Date

Patrick R. Scanlon

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